



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/369,391	08/06/99	ABELOW	D 03058/004002

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EXAMINER

DIXON, T

ART UNIT

PAPER NUMBER

2761

*4*

DATE MAILED:

02/15/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/369,391

Applicant(s)

ABELOW, DANIEL H.

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 October 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 48-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Priority***

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 37 CFR 1.78 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

It is noted that this application appears to claim subject matter disclosed in prior Application No. 08/934,457, and filed September 19, 1997. A reference to the prior application must be inserted as the first sentence of the specification of this application if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a). Also, the current status of all nonprovisional parent applications referenced should be included.

### ***Drawings***

2. This application has been filed with drawings which are objected to by the draftsman, and are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

See Form 948, Draftsman's Patent Drawing Review.

### ***Specification***

3. The disclosure is objected to because of the following informalities, for example:

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page 5, lines 6,7,9.11.15.17 all begin with a period, these appear to be items which might be bulleted or indented, other similar occurrences are on page 37, 40, 41, 53-58, 62-63 and others;

page 31, the brief descriptions of figures 8 and 9 are identical, but the drawings are different;

the specification is also marked with various editing characters, see examples on page 30, line 29; page 31, lines 5, 10 and 13; page 36, lines 29 and 31.

Appropriate correction is required.

#### ***Claim Objections***

4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 1-25 been renumbered 48-72.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 48-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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6. Claims 48-66 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. Specifically, the omitted elements of Claim 48 are:

receive information electronically regarding what value information would be necessary to make a product, service or information product valuable to the user, as perhaps a repository of customer desires or user-set preference flags, and

determining..., based upon triggers indicated by the customer desires database or user-set preferences,...useful for one of the clients (as indicated by in Figure 13 or Figure 23) .

7. Claim 55 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. Specifically, the omitted element of Claim 55 are: the ability of the software to determine what an "appropriate moment" is for displaying.

8. Claims 48-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Particularly, the use of the term "client" is confusing, at times it seems to refer to the device and other times to refer to the user of the device. For example, in Claim 48, lines 3, 10 and 17 seem to refer to the device, while line 10 seems to refer to a user of

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the device, but a different user than referred to in line 6. Similar examples exist in Claims 58, 61, 62, and 65.

9. Claim 55 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the term "appropriate moment" is confusing, because the phrase lacks a specificity which can be determined by the software.

10. Claim 72 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, lines 2, 7/ 8, and 10 refer to "value information" it is unclear if the "value information" of line 10 is the "value information" of line 2 or the "value information" of line 7/8. Also, the phrase "interacts with the value information" of line 9 is indefinite, it is unclear if the user is simply presented with the information or if the user must respond to further questions.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. Claims 67, 69 are rejected under 35 U.S.C. 102(b) as being anticipated by Kurland et al (4,603,232).

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As per Claim 67.

Kurland et al ('232) discloses a digital medium storing information generated by large numbers of independent users about the value of products, services, software or information, the medium being coupled to an electronic communication to enable regular interchange of new value information from the users stored value information from the medium, see Column 4, line 61 – Column 5, line 19.

As per Claim 69.

Kurland ('232) discloses all the limitations of Claim 67.

Kurland ('232) further discloses digital filters configured to identify patterns of sources of value information and fetch the identified information over the network, see Column 5, line 20 – Column 6, line 41.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 68, 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland et al (4,603,232) as applied to claim 67 above, and further in view of Frost (5,041,972).

As per Claim 68.

Kurland ('232) discloses all the limitations of Claim 67.

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Kurland ('232) does not disclose the users generate the new value information interactively while using the stored value information.

Frost (5,041,972) teaches users generating new value information interactively while using the stored value information, see Column 4, lines 34 – 50, for the benefit of selecting a set of attributes for market research which achieves the highest level of discrimination for each consumer interviewed.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of Kurland ('232) to allow the users to generate new value information interactively while using the stored value information as taught by Frost ('972), for the benefit of selecting a set of attributes for market research which achieves the highest level of discrimination for each consumer interviewed.

***Allowable Subject Matter***

13. Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action.

14. Claim 70 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Claim 71, which depends from Claim 70 would be allowable for the same reasons.

15. Claim 72 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action.




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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Friday 7 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Voeltz can be reached on (703) 305-9714. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9051 for regular communications and (703) 305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.

TAD   
February 7, 2000

  
EMANUEL TODD VOELTZ  
SUPERVISORY PATENT EXAMINER  
GROUP 2700